

PATENT

Application No.: 09/930,717
Attorney Docket No.: 00-065REMARKS

Prior to entry of this Response:

- Claims 1, 3-15, and 18-30 were pending in the present application
- Claims 1,3-15, and 18-30 stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims 1, 3-15, and 18-30 will be pending
- Claims 1, 11, and 24 will be the only independent claims

Telephone Interview

Applicants would like to thank the Examiner for the helpful telephone conversation held on October 3, 2003, with Applicants' representative.

The Examiner and Applicants' representative discussed the present application in light of the Adams reference. Applicants' representative suggested that Adams does not teach or suggest a feature generally directed to *an automated session comprising a plurality of lottery outcomes*, as generally recited in independent Claim 1.

Applicants' representative also stated that the feature of *a lottery server* is not "undefined" or indefinite as claimed in Claim 10. The Examiner agreed that *a lottery server* is not indefinite.

Applicants' representative also stated that the feature of *an automated session* is not "undefined" or indefinite as claimed in each of independent Claims 1, 11, and 24 (and other claims).

While no formal agreement was reached, Applicants are grateful for the opportunity to discuss the present application with the Examiner.

Section 112 Rejection

Claims 1-30 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse the Examiner's Section 112 rejection of Claims 1-30.

[Applicants note that the Examiner purports to reject previously-cancelled Claims 2, 16, and 17. Applicants believe that those cancelled claims were listed inadvertently. As Claims 2, 16, and 17 are not pending, the rejection is moot and is not discussed herein.]

Specifically, the Examiner states that the feature of *an automated session* (as recited in each of the independent Claims 1, 11, and 24) is "undefined." The Examiner also states that the feature of *a lottery server* (as recited in Claims 10 and 23) is "undefined." With respect to the *lottery server*, the Examiner further "notes that no provision to connect to a computer network is recited in the claims." [Office Action, page 2, section 4].

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As discussed with the Examiner during the Telephone Interview, the above features are not indefinite. The Examiner agreed that a *lottery server* is not "undefined" or indefinite.

The Examiner does not provide a reasoned explanation as to why the current language of any claim would be unreasonably unclear to one having ordinary skill in the art. The Examiner's Section 112 rejection therefore constitutes only a statement that the Examiner would prefer Applicants use different language.

Even if the Examiner considers the features of an *automated session* and a *lottery server* to be theoretically broad in scope, breadth of a claim is not to be equated with indefiniteness. If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. MPEP § 2173.04.

Also, the feature of an *automated session* is further qualified in each of the independent claims as *comprising a plurality of lottery outcomes* (Claim 1), *comprising a plurality of lottery games* (Claim 11), or *corresponding to a set of instant lottery outcomes* (Claim 24).

Applicants respectfully submit that the features of an *automated session* and a *lottery server* are described in the Specification in such a way as to enable one skilled in the art to make and/or use the invention, and set out the claimed subject matter with at least a reasonable degree of clarity and precision. Claims 1, 3-15, and 18-30 otherwise comply with all of the statutory requirements of Section 112.

Applicants respectfully request that the Examiner withdraw the Section 112, second paragraph rejection of Claims 1, 3-15, and 18-30.

Section 102(e) Rejection

Claims 1, 3-9, 11-15, and 18-28 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,848,932 issued to Adams ("Adams"). Applicants respectfully traverse the Examiner's Section 102(e) rejection.

Applicants respectfully submit that none of the independent Claims 1, 11, and 24 is anticipated by Adams. Adams does not teach or suggest all of the features of any of the independent Claims.

1.1. No suggestion of a plurality of lottery outcomes or lottery games

As best understood by Applicants, the Examiner asserts that Adams discloses:

- an *automated session comprising a plurality of lottery outcomes* (Claim 1)
- an *automated session comprising a plurality of instant lottery games* (Claim 11)
- an *automated session corresponding to a set of instant lottery outcomes* (Claim 24)

Applicants respectfully traverse these assertions. Applicants have carefully reviewed the Adams reference cited by the Examiner, without finding a teaching or suggestion of any of the above features.

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Adams discloses a system in which at least one indicia of a secondary game "separate from the primary game either physically or temporally" is utilized. In one example, the indicia of the secondary game (e.g., a secondary payout indicator) comprises a rotatable bonus wheel spun (e.g., automatically) in response to primary reels of a primary slot machine stopping on predetermined indicia. [Column 1, line 57 to Column 2, line 9].

2 As discussed with the Examiner during the Telephone Interview, the "rotatable bonus wheel" described in Adams is devoid of a hint or suggestion of an automated session comprising a plurality of lottery outcomes or lottery games. Specifically, the automatic spin of the bonus wheel is described as occurring only once. Adams does not suggest a plurality of automatic spins of the "bonus wheel."

There is nothing in the record that would support an assertion that the "bonus wheel" of Adams suggests an automated session comprising more than one outcome, much less more than one lottery outcome (Claim 1) or lottery game (Claim 11). Similarly, Adams is devoid of any hint of a session corresponding to a plurality of instant lottery outcomes, as recited in independent Claim 24.

3 1.2. Adams does not suggest terminating the automated session if the limiting criterion has occurred

Further, Adams, considered as a whole, does not fairly suggest features of *determining at least one parameter associated with the automated session, determining a limiting criterion based on the at least one parameter, determining if the limiting criterion has occurred, or terminating the automated session if the limiting criterion has occurred*. For example, the secondary game in Adams is always fixed at one bonus payout. Accordingly, Adams does not suggest a need for determining when to terminate an automated session comprising a plurality of lottery outcomes, much less a need for determining a parameter and limiting criterion associated with such an automated session.

4 1.3. No substantial evidence supporting the Examiner's assertion that Adams suggests a lottery outcome

In order to anticipate a claim, one of ordinary skill in the art must have understood each and every claim limitation to have been disclosed or inherent in a single prior art reference (at the time of the invention).

The term "lottery" does not even appear in Adams. The Examiner merely asserts: "Note that the claimed 'lottery outcome' is being read on the random outcome of the wheel (70) of ADAMS." [Office Action, page 3, section 6].

Applicants respectfully submit that the Examiner asserts that the Examiner is reading lottery outcome on the "random outcome of the wheel" of Adams. However, to establish a *prima facie* case of anticipation, both the claims and the prior art must be interpreted from the viewpoint of one of ordinary skill in the art (not the Examiner's viewpoint) at the time the invention was made.

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The Examiner does not provide any facts in support of an assertion that one having ordinary skill in the art at the time of the invention would have read the "wheel" of Adams as suggesting a *lottery outcome*, *lottery game*, or *instant lottery outcome*. Merely "noting" that this is the Examiner's interpretation is not sufficient evidence that one of ordinary skill would have had the same understanding.

Moreover, the Examiner does not make any finding as to the level of ordinary skill in the art at the time the invention was made, much less purport to interpret Adams from the objective viewpoint of one of ordinary skill at the time of the invention.

Accordingly, for at least the reasons stated herein, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation with respect to any of the independent Claims 1, 11, and 24 (and all of Claims 3-10, 12-15, 18-23, and 25-30 dependent therefrom).

Section 103(a) Rejection

Claims 10, 29, and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Adams, and further in view of Adams. Applicants respectfully traverse the Examiner's Section 103(a) rejection.

5 The Examiner states: "ADAMS does not disclose receiving or transmitting the results of the 'automated session' via a server, internet, or wireless communication." [Office Action, page 4, section 8]. The Examiner further states, however, that it would have been obvious to provide for such features in light of the asserted motivations of: (i) "to increase the game owner's information regarding the game outcomes" and (ii) "increasing the convenience to players."

1.1. Examiner's Implied Official Notice of Features and Motivations

The Examiner does not assert that either of the motivations (i) or (ii) is taught or suggested by Adams. Applicants respectfully submit that Adams does not suggest such motivations.

As the Examiner has not indicated any reference disclosing the asserted motivations or disclosing the claimed features, and has not indicated any reference in support of the level of ordinary skill in the art, Applicants presume that the Examiner intended to take Official Notice of both the features of Claims 10, 29, and 30 and the asserted motivations.

1.2. Improper Use of Official Notice

6 The Examiner's rejection of Claims 10, 29, and 30 is thus based in part on unsupported general assertions of what was "notoriously well known" before the time of Applicants' invention. [Office Action, page 4, section 8]. Applicants respectfully traverse the Examiner's Official Notice of the recited features Claims 10, 29, and 30.

Applicants note that the scope of the matter of which the Examiner takes Official Notice is limited to the substantial evidence in the record for such matter. As noted above, the cited

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Adams reference does not support the Examiner's broad assertions as to what was well known; the Examiner does not assert otherwise.

No references have been provided for any of the Examiner's assertions. Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner's brief statement, Applicants cannot properly determine the bounds of the prior art. Accordingly, for each of Claims 10, 29, and 30 Applicants:

- (i) dispute that the subject matter asserted was "notoriously well known" at the time the invention was made, and
- (ii) request a reference to clarify the subject matter in more detail.

MPEP 2144.03.

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Accordingly, the Examiner's sweeping assertions cannot be used as prior art to the present application – only the content of the references of record which are prior art to the present application may so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

1.3. Asserted Motivations Would Not Have Suggested the Specific Modifications

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Even if the Examiner had provided references in support of the asserted motivations, such motivations alone would not have reasonably suggested to one of ordinary skill in the art the specific features claimed.

For example, there is nothing in the Office Action or otherwise in the record suggesting that the asserted motivation of "increasing the convenience to players" would have led one having ordinary skill in the art to modify Adams to provide specifically for a device associated with an internet address (Claim 29) or transmitting at least one instant lottery outcome via wireless communication (Claim 30). The Examiner's assertion amounts to a statement that any modification merely increasing the convenience to a player would have been obvious at the time of invention.

Similarly, there is nothing in the Office Action or otherwise in the record suggesting that the asserted motivation of "to increase the game owner's information regarding the game outcomes" would have led one having ordinary skill in the art to modify Adams to provide specifically for receiving at least one lottery outcome from a lottery server (Claim 10).

For at least the reasons stated herein, Applicants respectfully request allowance of the pending Claims 1, 3-15, and 18-30.

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It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.


Petition for Extension of Time to Respond

Applicants hereby petition for a one-month extension of time with which to respond to the Office Action. Please charge \$55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

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Date



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